

Appl. No. 10/677,232
Amendment dated: November 23, 2005
Reply to OA of: July 25, 2005

REMARKS

Applicants acknowledge with appreciation the courtesy of the interview extended the Applicants' representative by Examiner Lavinder, the Examiner in charge of this application. At the interview the presently claimed invention, the outstanding Official Action, and the prior art references were discussed. Applicants' representative proposed several possible amendments to the claims that would further define the scope of the invention and differentiate the claimed invention from the prior art references.

First, Applicants' representative proposed amending the claims to more precisely recite that the rear portion of the clip set section served as the fixing point reference for the fixing section. The Examiner indicated that if such an amendment were made to the claims, the prior art rejections would likely be withdrawn. However, the Examiner also indicated that such an amendment would raise a new issue and therefore would only be entered and considered if filed in conjunction with a Request for Continued Examination.

Second, Applicants' representative proposed amending the claims to more precisely recite the anti-lateral vibrations means of the present invention. The Examiner indicated that if such an amendment were made to the claims, the prior art rejections would likely be withdrawn. However, the Examiner also indicated that such an amendment would raise a new issue and therefore would only be entered and considered if filed in conjunction with a Request for Continued Examination.

Finally, Applicants' representative proposed amending the claims to more precisely recite the stoppers formed at the end of the holding sections. The Examiner indicated that if such an amendment were made to the claims, the prior art rejections would likely be withdrawn. However, the Examiner also indicated that such an

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amendment would raise a new issue and therefore would only be entered and considered if filed in conjunction with a Request for Continued Examination.

Accordingly, Applicants submit herewith a Request for Continued Examination in conjunction with an Amendment that incorporates all of the amendments proposed during the Interview.

Claim 1 has been amended to more precisely recite the top portion of the fixing section has a hole that corresponds to a protrusion located on the top of the clip set section to serve as a means of preventing lateral vibration of the fixing section. Claim 1 has also been amended to recite that the clip set section has a rear end raised section that serves at the fixing reference point for the fixing clip. Support for these amendments to claim may be found throughout the specification as originally filed, including Figures 3A, 3B, 5, 6, 7, 8, 9 and 10.

Applicants have also amended Claim 4 to recite that the stoppers on the holding sections of the clip set section project downward towards the cylinder and extend past the opening that is the engaging section of the fixing section. Support for this amendment may be found throughout the specification as originally filed, including Figure 11.

Finally, Applicants have canceled claims 6 and 9 without prejudice or disclaimer. Claims 6 and 9 were canceled as being redundant in light of the amendment to claim 1.

Applicants respectfully submit that all claims currently pending in the present application are in full compliance with all of the requirements of 35 U.S.C. §112 and are now in condition for immediate allowance.

The rejection of claims 1, 4, 6 and 9 under 35 U.S.C. 103(a) as being unpatentable over Zepell in view of by Ganz has been carefully considered but is most respectfully traversed in light of the amendments to the claims and the following comments.

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Applicants wish to direct the Examiner's attention to the basic requirements of a prima facie case of obviousness as set forth in the MPEP § 2143. This section states that to establish a prima facie case of obviousness, three basic criteria first must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Section 2143.03 states that all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicants also most respectfully direct the Examiner's attention to MPEP § 2144.08 (page 2100-114) wherein it is stated that Office personnel should consider all rebuttal argument and evidence presented by applicant and the citation of In re Soni for error in not considering evidence presented in the specification.

The Official Action urges that Zepell discloses a clip fixing structure that meets all of the limitations of the present claims, except for that Zepell fails to disclose engaging sections being holes and holding sections being protrusions. The Official Action then urges that Ganz discloses engaging sections that are holes and holding sections that are protrusions and it would have been obvious to combine the teachings

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of Ganz with the invention of Zepell in order to provide tapered upper half sections on the holding sections to improve the ease of inserting the clip over the clip set section.

However, as acknowledged during the Interview, neither Zepell nor Ganz disclose a clip set section with a rear end raised section that serves as the fixing reference point for the fixing section as claimed in the currently amended claims. Zepell discloses a clip set section 45 which engages with the fixing section 53 by way of protrusions 51. However, the only reference point disclosed in Zepell is at the very back of the writing instrument where fixing section flange 62 meets flattened top surface 42. This is different from the present invention in that the rear end raised portion of the clip set section of the present invention serves as the fixing reference point, whereas the flattened top surface of the writing instrument is not part of the clip set section. The clip set section in Zepell is denoted by reference numeral 45. Further, the flattened top surface 42 of the writing instrument disclosed in Zepell cannot be reasonably interpreted as a rear end raised section, as recited in the currently amended claims. The flattened top surface does not extend above the cylinder of the writing instrument and, as mentioned before, is clearly not part of the clip set section 45 of Zepell. Therefore, Zepell clearly fails to disclose a rear end raised portion of the clip set section which serves a fixing reference point as claimed in the present application.

Ganz also fails to disclose a rear end raised portion of the clip set section as claimed in the present application. In Ganz, the clip set section 24 is located inside of the cylinder and therefore fails to protrude outwardly from the cylinder as claimed in the present application. Also, the only fixing reference point between the clip set section and the fixing section found in Ganz is the upper arm 50 meeting with the outside of the cylinder 18. Because upper arm 50 is part of the fixing section and not part of the clip set section, this feature clearly fails to meet the recitation of a rear end raised section of the clip set section as claimed in the present application. Therefore, it is clear that neither

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of the prior art references teach this limitation of the amended claim. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Also, with respect both Zepell and Ganz, neither reference discloses a hole in the top portion of the fixing section that corresponds to and engages with a protrusion on the top of the clip set section as claimed in the presently amended claims in order to prevent lateral vibration of the fixing structure. Accordingly, Applicants respectfully request that this rejection be withdrawn.

With respect to claim 4, the Official Action urges that Ganz discloses engaging sections 54 being holes and holding sections 27 and 28 being protrusions with the lower surface of the protrusions being stoppers to prevent the removal of the clip from the cylinder. However, Ganz clearly fails to disclose stoppers that extend downward towards the cylinder and below the opening of the engaging section as claimed in the presently amended claims and as illustrated in Figure 11. No portion of protrusions 27 and 28 extend downward towards the cylinder and below the opening of the engaging section, which can clearly be seen in Figure 3 of Ganz. The protrusions 27 and 28 are the same size as the openings through which they protrude and no portion of the protrusions extend downward and beyond the opening in order to better secure the fixing section to the clip set section. Also, it should be noted that neither Zepell nor Saitou disclose this feature of the presently amended claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

The rejection of claims 10 and 11 under 35 U.S.C. §103(a) has been carefully considered but is most respectfully traversed in light of the amendments to the claims and the following comments.

Claims 10 and 11 depend from independent claim 1. As explained in detail above, neither Zepell nor Ganz disclose or suggest every element of the presently amended claims. Saitou fails to remedy the deficiencies identified in Zepell and Ganz, and therefore Applicants respectfully request that this rejection be withdrawn.

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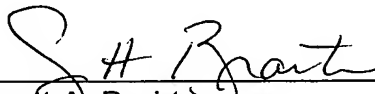
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In view of the above comments and further amendments to the claims, favorable reconsideration and allowance of all of the claims now present in the application are most respectfully requested.

Respectfully submitted,

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